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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,249	08/03/2005	Jean-Luc Girardet	18545-720.831	6456
21971 7590 02/17/2009 WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050				
EXAMINER				
FRAZIER, BARBARA S				
ART UNIT		PAPER NUMBER		
1611				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,249

Applicant(s)

GIRARDET ET AL.

Examiner

BARBARA FRAZIER

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 43-46 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52 is/are allowed.
- 6) ☒ Claim(s) 43-46 and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 22, 43-46, and 48-52 are pending in this application. Addition of new claims 50-52 is acknowledged.

Election/Restrictions

2. Applicant's election without traverse of Group II claims 43-45 in the reply filed on 01/08/2008 is acknowledged. Election of N-(2-bromo-4-methylphenyl)-2-(5-methyl-4-methylphenyl- 4H-[1,2,4]triazole-3-ylsulfanyl)-acetamide, now presented as new claim 52, is also acknowledged. New claims 50-52 will be examined with the elected group.

3. Claim 22 remains withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/9/08.

4. Upon further reconsideration, examination has been extended to include claims 46, 48, and 49, as the subject matter of said claims falls within the scope of independent claim 43, currently under examination.

5. Claims 43-46 and 48-52 are examined.

Priority

6. Examiner requests that a copy of PCT/US02/26816 (filed 8/23/2002) be provided, in order to determine the effective filing date of the subject matter in the claims of the instant application.

Specification

7. Applicant's amendment to the abstract, filed on 5/14/08, is duly noted.

Claim Rejections - 35 USC § 102

8. The rejection of claims 43-45 under 35 U.S.C. 102(b) as being anticipated by Soliman is withdrawn in view of Applicant's arguments, specifically that the Soliman publication does not disclose that R, which is covalently bound to a nitrogen of the 1,2,4-triazole, is a substituted aryl, as recited in claims 43-45.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 43, 50, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Shrimali et al (J. Indian Chem. Soc., 68(8), pp. 466-9, 1991).

The claimed invention is drawn to triazole and imidazole-substituted compounds according to Formula (VI)



as defined in claim 43 (see claim 43).

Shrimali et al disclose triazole compounds which are substituted with a thio-acetamide group (which is further substituted with an ortho-substituted phenyl ring) and two additional substituents (see page 466). Compounds 6i, 6k, and 6t in Table 1, page 467, read on the compounds of the claimed invention where HET is a triazole ring which is covalently bound to W and also is disubstituted with at least one substituted aryl, W is S, C(R₁)(R₂) – C(Y) – N(R₄) is an acetamide linkage, and R₅ is an ortho-substituted phenyl. Therefore, the compounds of Shrimali et al anticipate the compounds of the claimed invention.

Regarding claims 50 and 51, compounds 6i, 6k, and 6t of Shrimali et al read on the compounds of the claimed invention wherein the substituted aryl is phenyl substituted with a halogen (see claim 50) and the ortho-substituted phenyl is substituted with alkyl (methyl) or alkoxy (methoxy) (see claim 51).

11. Claims 43-46 and 48-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Simoneau et al (US 2005/0054639).

The claimed invention is drawn to triazole and imidazole-substituted compounds according to Formula (VI)



as defined in claim 43 (see claim 43).

Simoneau et al disclose triazole-substituted compounds of the formula



wherein Ar¹ is a triazole substituted with a substituted aryl in the 4-position, X is S or O, W is an acetamide group, and Ar² is an ortho-substituted phenyl which may be further substituted (for example, see paragraphs 65-83). For example, compounds 430 and 431 (page 41, Table 4) read on the compounds of the claimed invention wherein HET is a triazole ring substituted with methyl and a substituted aryl, W is S, C(R₁)(R₂) – C(Y) – NR₄ is an acetamide linkage, and R₅ is a phenyl substituted with a halogen in the ortho-position. Therefore, the invention of Simoneau et al anticipates the claimed invention.

Regarding claims 44, 45, 50, and 51, compounds 430 and 431 of Simoneau et al correspond to the claimed invention where R₁, R₂, and R₄ are hydrogen, one substituent of the 1,2,4-triazole is methyl and the other is a phenyl substituted with a halogen and an alkyl group, and the ortho-substituted phenyl is a phenyl that is ortho-substituted with a halogen.

Regarding claims 46, 48, and 49, compounds 430 and 431 of Simoneau et al correspond to the claimed invention where R₁ is methyl, R₂ is a disubstituted phenyl, R₃ is chloro, R₄ is hydrogen, and R₅ is hydrogen or SO₂Me.

Applicant cannot rely upon the claim to priority of PCT/US02/26816 to overcome this rejection because Applicants have not yet perfected the priority date based on said application.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. **Claims 43-46 and 48-51 are rejected on the ground of nonstatutory**

obviousness-type double patenting as being unpatentable over claims 1-19 of

U.S. Patent No. 7,435,752. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter.

The claimed invention is drawn to a compound having a structure according to Formula (VI) as defined in claim 43 or the formula (A) of claim 46, wherein the variables are defined in each claim. It is noted that the scope of claim 46 falls within the scope of claim 43.

US Patent 7,435,752 claims compounds of the same formula as Formula (A) that fall within the genus of the compounds of the instant application, specifically, wherein

R1 is halogen or lower alkyl, R2 is a substituted naphthyl, R3 is halogen, methyl, or trifluoromethyl, R4 is hydrogen, and R5 is C(O)R'. Therefore, the claims are drawn to the same art recognized subject matter.

14. **Claims 43-46 and 48-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 55 and 83 of copending Application No. 11/661,079.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter.

The claimed invention is drawn to a compound having a structure according to Formula (VI) as defined in claim 43 or the formula (A) of claim 46, wherein the variables are defined in each claim. It is noted that the scope of claim 46 falls within the scope of claim 43.

Copending application 11/661,079 claims compounds of the same formula as Formula (A) that fall within the genus of the compounds of the instant application, specifically, wherein R1 is halogen or (optionally substituted) lower alkyl, R2 is a substituted phenyl or naphthyl, R3 is halogen, methyl, or trifluoromethyl, R4 is hydrogen, and R5 is C(O)R' or S(O)2R'. Therefore, the claims are drawn to the same art recognized subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. **Claims 43-46 and 48-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over**

claims 55 and 83 of copending Application No. 12/114,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter.

The claimed invention is drawn to a compound having a structure according to Formula (VI) as defined in claim 43 or the formula (A) of claim 46, wherein the variables are defined in each claim. It is noted that the scope of claim 46 falls within the scope of claim 43.

Copending application 12/114,467 claims compounds of the same formula as Formula (A) that fall within the genus of the compounds of the instant application, for example, wherein R1 is optionally substituted lower alkyl or halogen, R2 is a substituted naphthyl, R3 is halogen or optionally substituted alkyl (see claim 58), R4 is hydrogen (see claim 61), and R5 is hydrogen, halogen, optionally substituted alkyl, C(O)R' or S(O)2R' (see claim 64). Therefore, the claims are drawn to the same art recognized subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

16. Claim 52 appears to be free of the prior art at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611